REMARKS

I. Status of the Claims

Claims 38-106 are pending. Claims 59, 61-68, 70-77, 80-82, and 85-87 are withdrawn from consideration by the Examiner as being directed to non-elected subject matter. No amendments are made in this submission.

II. Double Patenting Rejection

The Examiner maintained the rejection of claims 38-58, 60, 69, 78, 79, 83, 84, and 88-106 under the judicially created doctrine of obviousness-type double patenting over claims 1-41 of U.S. Patent No. 6,346,234 to Rollat et al. ("*Rollat*"), in view of EP 0 551 749 to Lee et al. ("*Lee*"). Final Office Action, page 2. The Examiner admitted that the claims of *Rollat* do not "expressly recite the second polymer herein, the fixing polymer." *Id.* To remedy this deficiency, the Examiner relied on the disclosure of *Lee* and alleged that "Lee, as secondary reference, is cited to show the level of the art, and therefore is not limited to the claims therein." Applicants respectfully traverse this rejection for the reasons of the record and at least the following reason.

The Examiner's reliance on *Lee*'s disclosure in support of the obviousness-type double patenting rejection and his allegation that *Lee* "is not limited to the claims therein" are improper. The M.P.E.P. clearly instructs that one significant difference between an obviousness-type double patenting rejection and an obviousness rejection is that "a double patenting rejection must rely on a comparison with the claims in [the prior art] while an obviousness rejection based on the same [prior art] relies on a

comparison of what is disclosed (whether or not claimed) in the same [prior art]." M.P.E.P. §804(III) (emphasis added). Therefore, as the claims of *Lee* do not support the Examiner's double patenting rejection, this rejection is improper.

Accordingly, Applicants respectfully request this rejection be withdrawn.

II. Rejection Under 35 U.S.C. § 112, First Paragraph

The Examiner maintained the rejection of claims 38-43, 45-50, 69, 78, 79, 83, 84, and 88-106 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement because allegedly the term "tacky polymer" used in the present claims is a functional limitation and its structure-property relationship is not disclosed. Final Office Action, page 3. Applicants respectfully traverse this rejection for the reasons of record and at least the following reasons.

First, the M.P.E.P. clearly instructs that "[t]he written description requirement for a claimed genus may be satisfied through sufficient description of a representative number of species by actual reduction to practice . . . or by disclosure of relevant, identifying characteristics, i.e., structure **or** other physical and/or chemical properties[.]" M.P.E.P. §2163 II.A.3(a).ii) (citing *Regents of the University of California v. Eli Lilly*, 119 F.3d 1559, 1568, 43 USPQ2d 1398, 1406 (Fed. Cir. 1997)) (emphasis added).

Therefore, contrary to the Examiner's allegation, it is not necessary to disclose the structure of all chemical compounds in a genus claim in order to satisfy the written description requirement. Disclosure of relevant, identifying characteristics, such as physical and/or chemical properties, can also satisfy the written description requirement.

Here, pages 4-6 of the present description provides guidance on how to determine the maximum peeling force F_{max} and the energy for separation $Es_{(M/V)}$, which are physical properties of the "tacky polymer" as presently claimed. These physical properties are not functional limitations as alleged by the Examiner.

Further, the present specification provides embodiments of the "tacky polymer" as presently claimed, such as branched sulphonic polymers or (meth)acrylic ester polymers on page 6, lines 21-23, guidance on how to form the branched sulphonic polyester and the (meth)acrylic ester, and specific examples thereof on page 7, lines 5 - page 12, line 16. Therefore, the present specification provides sufficient written description.

Finally, the M.P.E.P. clearly instructs that there is a strong presumption that an adequate written description of the claimed invention is present when the application is filed. M.P.E.P. § 2163(I)(*A*) (citing *In re Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976)). The Examiner has not met the burden to overcome this presumption in the present rejection. Therefore, this rejection is improper.

Accordingly, Applicants respectfully request this rejection be withdrawn.

III. Rejection Under 35 U.S.C. § 103 (a)

The Examiner also maintained the rejection of claims 38-58, 60, 69, 78, 79, 83, 84, and 88-106 under 35 U.S.C. § 103(a) over *Lee* in view of WO 95/18191 to Miller et al. ("*Miller*"). Final Office Action, page 4. The Examiner further asserted that "in the case where the claimed ranges 'overlap or lie inside ranges disclosed by the prior art' a prima facie case of obviousness exists." Advisory Action, page 2. Applicants

respectfully traverse this rejection for the reasons of record and at least the following reasons.

The issue here is not whether overlap of ranges is obvious as alleged by the Examiner, but whether it would have been obvious to pick and choose the claimed elements from the prior art and combine them together to arrive at the presently claimed invention. Applicants respectfully submit that the answer is no.

The Examiner has failed to point to any evidence of a suggestion or motivation to pick and choose tacky polymers with Tg of less than 20 °C from the "Eastman AQ polymers" disclosed in *Lee*. The Examiner's primary contention is that because *Lee* teaches that "Eastman AQ Polymers" can be combined with a water-soluble amphoteric polymer to form a composition, it would have been obvious for one of ordinary skill in the art to choose any species of the "East AQ Polymers" and combine it with the water-soluble amphoteric polymer disclosed in *Lee*. Final Office Action, pages 4 and 7. The Examiner's contention is similar to a species-genus argument, *i.e.*, because the broad genus is disclosed, then any species within that genus is obvious. The M.P.E.P. clearly states, however, that such an argument is improper if no evidence of suggestion or motivation for one of ordinary skill in the art to pick and choose a specific species from the disclosed genus. *See* M.P.E.P. § 2144.08 II.

Attempting to remedy this deficiency, the Examiner relied on *Miller* for its disclosure of the branched sulfonic polyesters with Tg which is alleged to be less than 20 °C. The Examiner's reliance on *Miller* is improper for at least the following reasons.

First, Applicants respectfully submit that *Miller* is not an analogous art. *Miller* discloses "a water-dissipatable or dispersible adhesive composition that is useful in

forming paper articles and other products that can be recycled through repulping in both neutral and alkaline media." *Miller*, abstract; *see* pages 1-3. The products using the adhesive composition disclosed in *Miller* include, for example, paper, paper products, woods, textile, plastics, and diapers. *Id.* at pages 1-3. However, *Lee* is directed to hairspray compositions. *See Lee*, page 1, line 1. Therefore, one of ordinary skill in the art would not be motivated to rely on *Miller* to remedy the deficiency of *Lee*.

Second, contrary to the Examiner's allegation that the branched sulfonic polyester disclosed in *Miller* has a Tg of less than 20 °C, *Miller* clearly teaches that "[t]he preferred Tg of the adhesive composition according to the present invention is below 10 °C." *Miller*, page 18, lines 1-3. *Miller* further teaches that a "low Tg means that the adhesive compositions will not be brittle[.]" *Id.* at lines 10-11. Therefore, the low Tg taught in *Miller* does not refer to the "branched sulfonic polyester" but to "the adhesive composition" disclosed therein.

Finally, given the fact that *Lee* teaches that among "Eastman AQ polymers," those having "a glass transition temperature ranging from about 50 °C to about 70 °C, preferably around 55 °C" are preferred (*Lee*, page 3, lines 17-19), one of ordinary skill in the art would not have been motivated to modify or combine *Lee*'s composition with a tacky polymer having Tg of less than 20 °C to arrive at the presently claimed invention.

Therefore, this rejection is improper. Accordingly, Applicants respectfully request this rejection be withdrawn.

IV. Conclusion

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

If the Examiner believes a telephone conference would be useful in resolving any outstanding issues, he is invited to call the undersigned Applicants' representative at (202) 408-4218.

If there is any fee due in connection with the filing of this response, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.

Date: April 24, 2006

By: Reg. No. 41,469
Ningling Wang
Reg. No. 52,412